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10/808,810

03/25/2004

Lewis Howard Wizig

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

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EXAMINER

PORTER, RACHEL L

ART UNIT

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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,810

Applicant(s)

WIZIG, LEWIS HOWARD

Examiner

RACHEL L. PORTER

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-69, 74-93, 98-117 and 122-124 is/are rejected.
- 7) ☒ Claim(s) 70-73, 94-97 and 118-121 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to the applicant

1. This communication is in response to the application filed 3/25/04. Claims 53-124 are pending.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/434,271, filed 11/04/1999 (now Pat. No. 6,735,569) . A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or

sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 101-124 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For an invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claim 101 recites "A computer readable medium comprising computer- readable code for providing a user with a customized healthcare services insurance package, comprising code for:...." in the preamble. Data structures not embodied or encoded on computer readable media are considered descriptive material. They are therefore considered non-statutory because they are not capable of causing a functional change in a computer. As drafted, the claim fails to define any structural and functional interrelationships between the computer program and other elements of a computer that permit the computer program's function to be realized. In particular, the current claim language describes the computer readable medium as comprising the code. (See MPEP § 2106.01 for further guidance)

A similar analysis may be applied to claims 102-124 which have similar language, and are also rejected.

NOTE: The art rejection of claims 101-124 is provided hereinbelow for the Applicant's consideration on the condition that the Applicant properly define the structural and functional interrelationships between the computer program and other elements of the computer as discussed above in the rejection under 35 U.S.C. 101.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 53-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,735,569. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elimination of a step or steps and the corresponding function if its function is not desired is an obvious modification of claims 1-19 of patent '569. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). Furthermore, it would be impossible to practice the method of claim 1 in patent '569 without infringing upon the method recited in claim 53 of the current application.

Similarly claims 77-124 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-38 of U.S. Patent No. 6,735,569. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elimination of a part or parts if the corresponding function(s) is/are not desired is an obvious modification of claims 20-38 of patent '569. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989), See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Allowable Subject Matter

7. Claims 70-73, 94-97 and 118-121 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 53-67, 73-91, 98-115 and 122-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (US Patent No. 5,519,607) in view of Campbell et al (USPN 6,208,974—referred to hereinafter as Campbell).

[claim 53] Tawil teaches a method for providing a user with a customized healthcare services insurance package, comprising:

- receiving personal information data, wherein personal data comprises a user identifier and a financial parameter; (col. 2, lines 53-56; col. 3, lines 55-59)
- transmitting a list comprising a plurality of healthcare service providers to the user; (col. 2, lines 53-59, col. 4, lines 55-58)
- receiving a selection of a healthcare services panel from the user comprising at least one of the healthcare service providers; (col. 4, lines 55-67; col. 5, lines 16-22)

Tawil teaches a method wherein personal data about a patient (a user of the disclosed system) is entered into the disclosed system. (col. 3, lines 55-59) Data includes patient name and social security number (personal identifiers). Furthermore, the system stores data on the amount of benefits or a fixed amount the patient can/will

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spend on healthcare (i.e. financial parameter). (col. 2, lines 53-56) The disclosed system provides the user with a list of healthcare providers (col. 2, lines 57-59, col. 4, lines 55-58). The patient (user of the disclosed system) selects a healthcare provider (i.e. panel) to provide a prescribed treatment plan (i.e. healthcare services package).

Tawil teaches a method including determining a healthcare services package (see Tawil col. 4, lines 55-64; col. 5, lines 16-22), but does not expressly teach using a computer system to determine the healthcare services package based upon a financial parameter and forwarding a description of the package that includes a proposed periodic payment for purchasing the healthcare insurance package.

Campbell teaches a method of further comprising the steps of:

- determining a healthcare services package based on the user's selection and a financial parameter (col. 21, lines 22-29; col. 24, lines 1-55; col. 27, lines 1-49: A computer system is used to enter the client's (i.e. users) selection of a wellness plan (i.e. healthcare services package), to inform the client of the services covered under a particular wellness plan and to inform the client/user of the estimated cost savings under a particular wellness plan. The determined wellness plan (i.e. health care services package) is based on the user/client's selections and the estimated costs/cost savings for services under the plan (i.e. a financial parameter)).
- forwarding a description of the determined healthcare services package to the user, said description including a proposed periodic payment for purchasing said

determined healthcare services package. (Figures 15, 19 and 20; col. 24, lines 24-67; col. 27, line 23-50 —The system generates a list of the services included in the client's (i.e. user) wellness plans and a corresponding invoice, and also allows the client to select a propose payment schedule for purchasing the selected services (i.e. full payment or installments).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of Campbell to use a computer to facilitate the plan selection process and to transmit plan service and payment information to the user. As suggested by Campbell, one would have been motivated to do this to provide patients with an interactive, effective method of obtaining affordable healthcare treatment, thereby encouraging them to seek appropriate treatment and resolve health problems early. (col. 1, lines 11-65)

[claim 54] Tawil teaches the method wherein the user is an individual for whom the insurance is to be provided. (col. 2, line 30-44; col. 4, lines 55-67)

[claim 55] Tawil discloses a method wherein the personal information data further comprises a sponsor identifier. (Tawil, col. 2, lines 30- col. 3, line 8).

[claim 56-57] Tawil teaches the method of claims 54-55 as explained in the rejections of claims 54-55. The Tawil reference is does not specifically teach the sponsor identifier includes an employer of the user/patient and that the financial parameter includes the

amount of healthcare benefits available from the employer. However, as defined by Tawil, the “insurer” in as an entity that insures several parties a processes the claims for these parties.

However, these differences are only found in nonfunctional description material and are not functionally involved in the steps recited. The steps recited in claim 53(the base claim) would be performed the same regardless of the data contents of the sponsor identifier data (i.e. the data recited in claims 53 and 54). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gluck*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

[claim 58] Tawil discloses a method wherein the sponsor identifier includes a healthcare administration company associated with the user. (Tawil, col. 2, lines 30- col. 3, line 8).

[claim 59] Tawil discloses a method wherein the financial parameter comprises an amount of healthcare benefits available from the healthcare administration company associated with the user, (Tawil, col. 2, lines 55-59; col. 3, lines 4-8—fixed benefit amount).

[claim 60] Tawil discloses a method wherein the sponsor identifier identifies the user. (Tawil, col. 2, lines 30- col. 3, line 8; col. 3, lines 50-65).

[claim 61] Tawil discloses a method wherein the financial parameter comprises an amount of healthcare costs identified by the user, (Tawil, col. 8, lines 24-26) (payment/cost).

[claim 62] Tawil teaches a method wherein the personal data comprises a financial parameter. (col. 2, lines 53-56) Furthermore, Tawil teaches a method wherein the user (i.e. insured and/or insured patient) is seeking price estimates for the cost of healthcare services. (col. 3, lines 57-63) One of the primary purposes of the system and method taught by Tawil is to provide the user with a list of estimated costs of healthcare using specific providers. (col. 4, 55-64)

[claims 63-64] Tawil teaches a method further comprising using a computer system to receive the selection of an anchor provider by a user and wherein a list of providers is provided to the system user (i.e. insured and/or insured patient) based on a selected anchor provider. (col. 3, lines 50-65) A patient (a user of the disclosed system) visits a selected primary physician (i.e. anchor provider) who gives them an initial diagnosis and/or treatment plan. Information regarding the primary physician (his/her identification) and the suggested user's treatment plan are entered into the system. (col. 3, lines 55-64) Thus, system receives a selection by the user (insured and/or insured patient) of an anchor provider. Based on the treatment plan developed by the primary physician (anchor provider), a list of healthcare providers is generated who can perform the procedures in the treatment plan. (col. 4, lines 21-32) This list is given to the patient (i.e. user) for his/her review. (col. 4, lines 55-58). Furthermore, the treatment plan developed by the anchor provider with suggested procedures and CPT codes is used to

generate the provider list. These procedures/diagnoses serve as a predefined criteria associated anchor provider upon which the generated provider list is based.

[claim 65] Tawil teaches the method of providing a healthcare services package further comprising using said computer system to receive a selection of a predefined criteria from the user. (col. 2, lines 53-59; col. 3, lines 3-8; col. 3, lines 23-44; col. 4, lines 21-32) Tawil discloses that teaches that the system database(s) stores information regarding prices, geographic proximity (location), rankings/ratings, hospital affiliation, and provider experience (i.e. time). (col. 2, lines 53-59; col. 3, lines 3-8).

[claim 66-67] Tawil discloses a method further comprising the step of receiving a selection of a predefined criteria from the user wherein the list is provided to the user based on the predefined criteria, (Tawil, col. 2, lines 53-59; col. 3, lines 3-8; col. 4, lines 28-32). Tawil teaches that the information on the database (i.e. the provider list) may be accessed based on the providers' geographic proximity (location/distance) to the user (i.e. insured/ or insured patient) and based upon the CPT and DRG codes entered for the user's treatment plan (i.e. predefined criteria)

[claim 74] Tawil discloses a method wherein the financial parameter comprises a co-payment amount for each selected provider (Tawil, col. 8, lines 24-26)(disclosing payment which is a financial parameter that includes cost).

[claim 75] Tawil and Campbell disclose the method of claim 53, as explained in the rejection of claim 53. Furthermore, Campbell discloses a method wherein forwarding comprises forwarding information to the user (col. 24, lines 24-67; col. 27, line 23-50). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of Campbell to use a computer to facilitate the plan selection process and to transmit plan service information to the user. As suggested by Campbell, one would have been motivated to do this to provide patients with an interactive, effective method of obtaining affordable healthcare treatment, thereby encouraging them to seek appropriate treatment and resolve health problems early. (col. 1, lines 11-65)

[claim 76] Tawil and Campbell in combination disclose the method of claim 53, as explained in the rejection of claim 53. Furthermore, Tawil discloses teaches a method for providing a user with a healthcare service package, comprising receiving personal information data, wherein personal data comprises a user identifier and a financial parameter; (col. 2, lines 53-56; col. 3, lines 55-59). Tawil further discloses receiving co-payment information regarding a healthcare provider (col. 8, lines 12-23) Tawil teaches a method including determining a healthcare services package (see Tawil col. 4, lines 55-64; col. 5, lines 16-22), but does not expressly teach receiving a selection from said user of a co-payment for each of healthcare service providers, wherein said healthcare services insurance package and said proposed periodic is determined based upon the selected co-payment.

Campbell discloses a method wherein co-payment information for a healthcare provider is used to help the user select/determine the insurance package and proposed periodic payment. (col. 23, lines 43-col. 25, line 24; Figures 17-19--different plans offer different discounts/copays for the services) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of Campbell to use co-payment information to help the user select/determine the insurance package and proposed periodic payment. As suggested by Campbell, one would have been motivated to do this to provide patients with an interactive, effective method of obtaining affordable healthcare treatment, thereby encouraging them to seek appropriate treatment and resolve health problems early. (col. 1, lines 11-65)

[claim 77] Tawil discloses a computerized system for providing a user with a customized healthcare services insurance package, comprising: a memory device; (Figure) and a processor disposed in communication with said memory device, (Figure 1; col. 2, line 45-col. 3, line 43; col. 4, lines 35-41).

The limitations of claim 77 are addressed by rejection of claim 53, and incorporated herein. Claim 77 recites a processor configured to perform the series of steps recited in claim 53. As the method of claim 53 has been shown to be computer-implemented and obvious over the teachings of the Tawil reference in view of Campbell in the rejection of claim 53 in present Office Action, it is readily apparent that the method

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disclosed by Tawil and Campbell in combination is performed by a system configured to perform the functions recited in the method claim.

[claim 78] Tawil teaches the system wherein the user is an individual for whom the insurance is to be provided. (col. 2, line 30-44; col. 4, lines 55-67)

[claim 79] Tawil discloses a system wherein the personal information data further comprises a sponsor identifier. (Tawil, col. 2, lines 30- col. 3, line 8).

[claim 80-81] Tawil teaches the system of claims 78-79 as explained in the rejections of claims 78-79. The Tawil reference is does not specifically teach the sponsor identifier includes an employer of the user/patient and that the financial parameter includes the amount of healthcare benefits available from the employer. However, as defined by Tawil, the "insurer" in as an entity that insures several parties a processes the claims for these parties.

However, these differences are only found in nonfunctional description material and are not functionally involved in the steps recited. The steps recited in claim 53(the base claim) would be performed the same regardless of the data contents of the sponsor identifier data (i.e. the data recited in claims 53 and 54). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

[claim 82] Tawil discloses a system wherein the sponsor identifier includes a healthcare administration company associated with the user. (Tawil, col. 2, lines 30- col. 3, line 8).

[claim 83] Tawil discloses a method wherein the financial parameter comprises an amount of healthcare benefits available from the healthcare administration company associated with the user, (Tawil, col. 2, lines 55-59; col. 3, lines 4-8—fixed benefit amount).

[claim 84] Tawil discloses a system wherein the sponsor identifier identifies the user. (Tawil, col. 2, lines 30- col. 3, line 8; col. 3, lines 50-65).

[claim 85] Tawil discloses a system wherein the financial parameter comprises an amount of healthcare costs identified by the user, (Tawil, col. 8, lines 24-26) (payment/cost).

[claim 86] Tawil teaches a system wherein the personal data comprises a financial parameter. (col. 2, lines 53-56) Furthermore, Tawil teaches a method wherein the user (i.e. insured and/or insured patient) is seeking price estimates for the cost of healthcare services. (col. 3, lines 57-63) One of the primary purposes of the system and method taught by Tawil is to provide the user with a list of estimated costs of healthcare using specific providers. (col. 4, 55-64)

[claims 87-88] Tawil teaches a system further comprising using a computer system to receive the selection of an anchor provider by a user and wherein a list of providers is provided to the system user (i.e. insured and/or insured patient) based on a selected

anchor provider. (col. 3, lines 50-65) A patient (a user of the disclosed system) visits a selected primary physician (i.e. anchor provider) who gives them an initial diagnosis and/or treatment plan. Information regarding the primary physician (his/her identification) and the suggested user's treatment plan are entered into the system. (col. 3, lines 55-64) Thus, system receives a selection by the user (insured and/or insured patient) of an anchor provider. Based on the treatment plan developed by the primary physician (anchor provider), a list of healthcare providers is generated who can perform the procedures in the treatment plan. (col. 4, lines 21-32) This list is given to the patient (i.e. user) for his/her review. (col. 4, lines 55-58). Furthermore, the treatment plan developed by the anchor provider with suggested procedures and CPT codes is used to generate the provider list. These procedures/diagnoses serve as a predefined criteria associated anchor provider upon which the generated provider list is based.

[claim 89] Tawil teaches the system of providing a healthcare services package further comprising using said computer system to receive a selection of a predefined criteria from the user. (col. 2, lines 53-59; col. 3, lines 3-8; col. 3, lines 23-44; col. 4, lines 21-32) Tawil discloses that teaches that the system database(s) stores information regarding prices, geographic proximity (location), rankings/ratings, hospital affiliation, and provider experience (i.e. time). (col. 2, lines 53-59; col. 3, lines 3-8).

[claim 90-91] Tawil discloses a method further comprising the step of receiving a selection of a predefined criteria from the user wherein the list is provided to the user

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based on the predefined criteria, (Tawil, col. 2, lines 53-59; col. 3, lines 3-8; col. 4, lines 28-32). Tawil teaches that the information on the database (i.e. the provider list) may be accessed based on the providers' geographic proximity (location/distance) to the user (i.e. insured/ or insured patient) and based upon the CPT and DRG codes entered for the user's treatment plan (i.e. predefined criteria)

[claim 98] Tawil discloses a system wherein the financial parameter comprises a co-payment amount for each selected provider (Tawil, col. 8, lines 24-26)(disclosing payment which is a financial parameter that includes cost).

[claim 99] Tawil and Campbell disclose the method of claim 77, as explained in the rejection of claim 77. Furthermore, Campbell discloses a system wherein forwarding comprises forwarding information to the user (col. 24, lines 24-67; col. 27, line 23-50). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tawil with the teaching of Campbell to use a computer to facilitate the plan selection process and to transmit plan service information to the user. As suggested by Campbell, one would have been motivated to do this to provide patients with an interactive, effective method of obtaining affordable healthcare treatment, thereby encouraging them to seek appropriate treatment and resolve health problems early. (col. 1, lines 11-65)

[claim 100] Tawil and Campbell in combination disclose the system of claim 77, as explained in the rejection of claim 77. Furthermore, Tawil discloses teaches a system for providing a user with a healthcare service package, comprising receiving personal information data, wherein personal data comprises a user identifier and a financial parameter; (col. 2, lines 53-56; col. 3, lines 55-59). Tawil further discloses receiving co-payment information regarding a healthcare provider (col. 8, lines 12-23) Tawil teaches a system including determining a healthcare services package (see Tawil col. 4, lines 55-64; col. 5, lines 16-22), but does not expressly teach receiving a selection from said user of a co-payment for each of healthcare service providers, wherein said healthcare services insurance package and said proposed periodic is determined based upon the selected co-payment.

Campbell discloses a system wherein co-payment information for a healthcare provider is used to help the user select/determine the insurance package and proposed periodic payment. (col. 23, lines 43-col. 25, line 24; Figures 17-19--different plans offer different discounts/copays for the services) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of Campbell to use co-payment information to help the user select/determine the insurance package and proposed periodic payment. As suggested by Campbell, one would have been motivated to do this to provide patients with an interactive, effective method of obtaining affordable healthcare treatment, thereby encouraging them to seek appropriate treatment and resolve health problems early. (col. 1, lines 11-65)

[claim 101] In reference to claim 101, the computer program claim recites substantially the same subject matter of method claim 53 as media comprising program/code to perform the series of steps recited in claim 53. As the method of claim 53 has been shown to be computer-implemented and obvious over the teachings of the Tawil reference in view of Campbell in the rejection of claim 53 of the present Office Action, it is readily apparent that the method disclosed by Tawil and Campbell in combination is performed using computer program means to implement the functions recited in the method claim (claim 53). As such, these limitations are rejected for the same reasons given in the rejection of method claim 53, and are incorporated herein.

[claims 102-115 and 122-124] The limitations of claims 102-115 and 122-124 are addressed by the rejections of claims 53-67 and 73-76 respectively, and independent claim 101, and incorporated herein.

10. Claims 68-69, 92-93, and 116-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil and Campbell as applied to claims 53, 77, and 101 in further view of DeBruin-Ashton (US Patent No. 6,014,629).

[claim 68] Tawil teaches the method of claim 53 as explained in the rejection of claim 53. Furthermore, Tawil discloses that the system is for use by the insured party, including an insured individual as well as any dependents who are covered by the insured's policy (col. 2, lines 48-50). Tawil also teaches a method wherein the user's

(i.e. insured/insured patient) name is associated with the treatment plan and a provider list. (col. 2, lines 53-59; col. 3, lines 53-57) Tawil does not specifically teach that the personal data further comprises identification of a plurality of individuals to be associated with the healthcare services package. DeBruin-Ashton teaches a method of identifying a plurality of individuals to be associated a healthcare services package. (col. 7, lines 1-15, col. 8, lines 22-35). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of DeBruin-Ashton. One would have been motivated to include this feature so that users (insured and/or insured patient(s)) could save time and avoid the inconvenience of unnecessary trips to a primary provider to receive additional provider lists.

[claim 69] Tawil and Campbell disclose the method of claim 53 as explained in the rejection of claim 53. Tawil does not specifically teach a method wherein a healthcare service panel and package for each a plurality of individuals are selected by the user. DeBruin teaches a method wherein a user may select a healthcare services panel of providers and services for a plurality of individuals. (DeBruin: col. 8, lines 22-35). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Tawil with the teaching of DeBruin. As indicated by Tawil, the disclosed system/method is for use by insured individuals and their dependents. (col. 2, lines 48-50). One would have been motivated to modify the method of Tawil so that an insured (e.g. parent) also could make selections

provider/service for their dependents (e.g. children) that comply with financial constraints and personal preferences.

[claims 92-93] In reference to claims 92-93, the limitations of these system claims are substantially the same as their corresponding method claims, claims 68 and 69. As such, the limitations of claims 92-93 are addressed by the rejections of claims 68 and 69, and independent claim 77, and incorporated herein.

[claims 116-117] In reference to claims 116-117, the limitations of these system claims are substantially the same as their corresponding method claims, claims 68 and 69. As such, the limitations of claims 116-117 are addressed by the rejections of claims 68 and 69, and independent claim 101, and incorporated herein.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

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/R. L. P./
Examiner, Art Unit 3626

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626